

Application No. 10/617,930
Brignac et al.

REMARKS

Claims 49-68 are pending in the application. Claims have been rejected under 35 U.S.C. 112 and 35 U.S.C. 102 in the Office Action dated September 30, 2005. Applicant wishes to thank the Examiner for the courtesy of an interview conducted November 17, 2005 in which a useful discussion toward progressing these claims and application to patent took place. In view of the interview and these remarks below, reconsideration is respectfully requested.

As stated by Applicant during the interview, the claims as amended in Applicant's July 20, 2005 response are clearly directed to an automated and cooperative sample repository system comprising *inter alia* samples stored on fibrous DNA-immobilizing media, and means for removing a portion of said fibrous media comprising said immobilized sample.

Support for the claimed feature of fibrous DNA-immobilizing media in the automated repository is found in the present specification at page 5, line 9 through page 6, line 2. In addition, the use of fibrous media in an automated multiple use sample repository is found in the Provisional Application U.S. 60/161,694, filed October 26, 1999, which was expressly incorporated by reference at page 1 as part of the disclosure of the present application. (A copy of the Provisional Application as filed, and as available on the PAIR system, is provided with this Communication.) Additional support for the distinctly claimed feature of fibrous (paper) sample substrate is found at page 2, line 6 through page 3, line 10 of the Provisional Application.

The enabling description of the present application, including the Provisional Application, supports the claimed inclusion of fibrous DNA-immobilizing media. The plain meaning of "paper" is well known in the art to include "fibrous media", which is the more

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precise term. Webster's Dictionary primarily defines "paper" as "... a thin, flexible material made usually in sheets from a pulp prepared from rags, wood, or other fibrous material". The "DNA-immobilizing" feature is enabled by the recitation of FTA paper (see for example page 5, line 14), and the other descriptive text in the above cited sections of the specifications. The inclusion of this element in an automated sample archive is a clear distinction over the prior art sample storage and retrieval systems.

The support of claim features through incorporation by reference is acceptable and must not be discounted, as established by *In re Haworth* 210 U.S.P.Q. 689 (CCPA 1981). Such support is not to be considered new matter, as set forth by *In re Hawkins* 179 U.S.P.Q. 157 (CCPA 1973).

Applicant respectfully asserts the specification enables one skilled in the art how to make and use the claimed invention without undue experimentation. If the Examiner does not agree the claimed distinctive elements are supported and enabled, they are respectfully invited to identify what alternative claim scope is considered to be enabled, per M.P.E.P 2164.08.

Moreover, it is respectfully stated that none of the cited references disclose or suggest the presently claimed invention. In fact, the references depict quite the opposite, that is, the handling and limitations presented with fluid handling sample systems. None of the references suggest an automated repository system combining corresponding medical information for archival of samples stabilized on DNA-immobilizing media, and clearly none would be operable as such a storage archive. It is respectfully requested the above rejections under 35 U.S.C. 112 and 102 (b) be removed.

It is respectfully asserted that the present claims are patentable over the prior art, and none of the cited references disclose, nor suggest the presently claimed invention. None of the prior art, alone or in any reasonable combination, would be operable as the system and means presently claimed.

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Again, Applicant thanks the Examiner for the discussion opportunity afforded by the interview. If the Examiner believes that a telephone conference with the undersigned would expedite passage of the present claims and patent application to allowance and issue, they are cordially invited to call the undersigned at the number below.

Respectfully submitted,

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